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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,787	02/14/2002	David P. Lobeck	DL01	2195
27797	7590	08/28/2008	EXAMINER	
RICHARD D. FUERLE 1711 W. RIVER RD. GRAND ISLAND, NY 14072			D'AGOSTINO, PAUL ANTHONY	
			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			08/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/683,787

**Applicant(s)**

LOBECK, DAVID P.

**Examiner**

Paul A. D'Agostino

**Art Unit**

3714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This responds to Applicant's Arguments/Remarks filed 6/30/2008. Claim 10 has been amended. Claims 7-8 have been cancelled. Claims 1-6 and 9-22 are pending in this application.

#### ***Claim Objections***

1. Claim 10 has been amended appropriately. The objection of Claim 10 is withdrawn.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3-4, 10, 12-13, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,220,916 to Bart et al. (Bart) in view of U.S. Patent No. 5,692,966 to Wash (Wash) and U.S. Patent No. 5,779,567 to Durso (Durso).

Bart discloses a pre-recorded message device on a spring band (Fig. 1 and Col. 1 Lines 40-57 where "The audio broadcast unit may be removed from the bistable band ...") comprising a body that has vertical, cylindrical sides that can be struck by a moving golf ball (Figs. 4 and 9 with a diameter of approximately 29mm Col. 4 Lines 55-56; also, "The audio broadcast unit can also be easily separated from the bistable spring and actuated independently from the spring upon the striking of the audio broadcast unit upon any object in order to activate the pre-recorded audio message stored therein." Col. 5 Lines 52-56), said body having a head portion (Fig. 7 everything contained within "housing" 16 above "lower portion" 28 up to and including "dome" 23) and a base (Fig. 7, "lower portion" 28), where

(I) said head portion contains:

(A) at least one battery (Figs. 3, 7 and 8 "batteries" 22 Col. 3 Line 65 );

(B) an electronic sound generator {integrated circuit chip} (Fig. 3 "ROM chip pre-recorded audio message" 19) that generates a sound when energized by said battery (Fig. 3 and "power from the batteries 22 to the memory device 19 and to speaker 20 causing the pre-recorded message to be broadcast from speaker 20" Col. 3 Lines 65-67 and Col. 4 Lines 1-2); and

(C) a single sensor switch (Figs. 3 and 7 and "impact switch" 18 Col. 3 Lines 46-48) that closes an electrical circuit (Fig. 6) connecting said battery to

said electronic sound generator (Fig. 6) when said device is struck by a golf ball coming from any direction (Figs. 4 and 6 and "Deployment of impact switch 18 which is a momentary switch, once closed, will provide power from the batteries 22 to the memory device 19 and to speaker 20 causing the pre-recorded message to be broadcast from speaker 20" Col. 3 Lines 65-67 and Col. 4 Lines 1-2; wherein the sensor can be located on top, underneath, or on the outside of housing 16 Col. 5 Lines 26-29).

{an electrical circuit connecting said battery, said sensor switch, said integrated circuit chip, and said speaker (Figs. 3 and 4), whereby said circuit is closed when said sensor switch is both closed ("impact switch 18 is a momentary switch, once closed, will provide power from the batteries 22 to the memory device 19 and to speaker 20 causing the pre-recorded message to be broadcast from speaker 20" Col. 3 Lines 65-67 and Col. 4 Lines 1-2).}

However, Bart fails to disclose an on-off switch that enables the user of said golf practice device to turn said golf practice device on or off such that the device is closed only when the on-off switch and the sensor are closed; and said base selected from the group consisting of a pin that can be pushed into the ground and material made of small hooks that can be releasably attached to a fabric.

Wash teaches of a golf putting training device (Fig. 2) and method wherein an on-off switch enables the user of said golf practice device to turn said golf practice device on or off (Fig. 2 "OFF ON" switch 14 and Col. 5 Lines 27-28) in order to provide a

portable golf putting training device having a means to preserve battery life (Col. 4 Lines 43-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the on or off switch as taught by Wash into the teachings of Bart, such that in combination with the closure of the sensor the device activates, in order to provide a portable golf putting training device having a means to preserve battery life.

Durso teaches of a golf swing touch trainer (Col. 2 Line 23) and method that is portable wherein the base can include spiking into the ground or a material made of small hooks that can be releasably attached to a fabric (Figs. 1-5 "golf swing touch trainer 100" and "It is a generally portable item, i.e., is portably-sized, although it may be fastened to a surface more permanently such as by spiking, gluing, or otherwise affixing it permanently or removably, e.g., by making it to have its bottom surface include a hook portion of a hook and loop substance such as VELCRO (Reg. U.S. Pat. & Tm. Off.) fastener material, which may attach to a complimentary loop portion which may include the pile of certain carpets. Preferably, the trainer 100 is fully portable and if attachable, removably attachable" (Col. 3 Lines 18-28); and wherein "The trainer is placed on a suitable surface such as an actual grass or sand putting green, artificial turf, a carpet or rug, and so forth" (col. 5 Lines 15-17) in order to help a student of the game of golf to effectively, rather, quickly, not only develop his aim, but also, most importantly, develop his golf swing touch, especially with stokes of putting and chipping" (Col. 2 Lines 38-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the fastening means and placement on a carpet as taught by Durso into the teachings of Bart as modified by Wash in order to help a student of the game of golf to develop his aim and sense of golf swing touch, especially with strokes of putting and chipping.

5. Claims 2, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,220,916 to Bart et al. (Bart) in view of U.S. Patent No. 5,692,966 to Wash (Wash) and U.S. Patent No. 5,779,567 to Durso (Durso) and further in view of U.S. Patent No. 5,584,768 to Lee (Lee).

Bart, as modified by Wash and Durso, discloses a system and method substantially equivalent to Applicant's claimed invention. However, Bart, as modified by Wash and Durso is silent on whether the base includes a spike.

Lee teaches of bases including a pin that can be pushed into the ground (Fig. 1) of a putting green ("for securing the device into the ground such as a golf green" Col. 1 Lines 32-33) in order to provide a golf ball putting aid "for use by a golf putter for a person to train and practice putting a golf ball more accurately" (Col. 1 Lines 25-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the base with pin and location on a golf green as taught by Lee into the teachings of Bart, as modified by Wash and Durso in order to provide a golf ball putting aid for use by a golf putter for a person to train and practice putting a golf ball more accurately.

6. Claims 5-6, 15-16, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,220,916 to Bart et al. (Bart) in view of U.S. Patent No. 5,692,966 to Wash (Wash) and U.S. Patent No. 5,779,567 to Durso (Durso) and further in view of U.S. Patent No. 5,067,718 to Knox et al. (Knox).

Bart as modified by Wash and Durso discloses "The audio message may contain music, words, or a variety of sounds as desired and are well known in the art" (Col. 5 Lines 58-62) but is silent on specifically the sounds of a ball falling into a cup and a human voice.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include signature golf sounds (e.g., ball falling into the cup, striking the pin, crowd cheering) or spoken words of recognition from peers (e.g., "nice shot", "you drained it") onto the pre-recorded audio memory.

Further, Knox teaches of a ball falling into a cup and of a human voice ("Although the device has no actual "hole" into which an on-target putt drops, the conditions under which actual putting takes place are realistically simulated. The display informs the participant whether the putt was on target or off target and on which side of the target it missed, and the ball speed is also given so that the participant can immediately see that its speed was about right or perhaps rather high such that the putt would roll well beyond the hole if off target. Adding to the realism are sound effects which include a realistic simulation of a golf ball dropping into a cup for on target putts and a "cat call" or



"raspberry" sound for off target putts. (Col. 1 Lines 60-67 and Col. 2 Lines 1-4) in order to provide a putting practice and/or amusement device (Col. 1 Line 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the audio messages as taught by Knox into the teachings of Bart, as modified by Wash and Durso in order to provide a putting practice and/or amusement device.

7. Claims 9, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,220,916 to Bart et al. (Bart) in view of U.S. Patent No. 5,692,966 to Wash (Wash) and U.S. Patent No. 5,779,567 to Durso (Durso) and further in view of U.S. Patent No. 2,184,868 to Williams et al. (Williams).

Bart as modified by Wash and Durso discloses wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball ("Any conventional switch common in the industry may be used such as a barrel-spring momentary contact switch, an inertia switch, or a conventional momentary contact switch" (Col. 4 Lines 65-67 and col. 5 Line 1). However, Bart as modified by Wash and Durso does not explicitly disclose a sensor switch of a spring making contact with a ferrule when the device is struck by an object the size of a golf ball.

Williams teaches of a bumper sensor (Figs. 1-4) whereby upon impact by ball 36 rolling over a board 12 may engage the side of the spring 10 and move the latter in a radial direction toward the mounting post so as to cause the central contact ring portion

17-17a to bear against the sleeve 14, thus closing a circuit (Page 2, Col. 1, Lines 15-31) in order to provide an improved bumper switch for use in an amusement apparatus (Page 1, Col. 1, Lines 1-9). However, Williams teaches the claimed sensor limitation except for the spring 10 is outside of (not inside of) ferrule 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reverse the parts since it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the bumper sensor as taught by Williams into the teachings of Bart, as modified by Wash and Durso in order to provide an improved bumper switch for use in an amusement apparatus.

### ***Response to Arguments***

8. Applicant argues the switch of Wash would not fit in the device of Bart since Bart's device is miniaturized (see Applicant's Arguments/Remarks page 8). Examiner respectfully disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). What is suggested is the addition of the switch of Wash into the device of Bart to preserve battery life. Thus, the rejection is maintained.

9. Applicant argues there's no need to add a switch to Bart as the device is always off except when struck and since Bart is a child's toy wherein accidental triggering would be "humorous, not a social crisis" (see Applicant's Arguments/Remarks page 2). Examiner respectfully disagrees. The fact that applicant has recognized another advantage (i.e., avoiding social crisis) which would flow naturally from following the suggestion of the prior art (e.g, adding the switch of Wash to Bart to preserve battery power and since the device is off there is not chance of social crisis) cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
10. Applicant argues that the addition of the spike of Durso interferes with the proper function and intended purpose of the SLAP BAND of Bart (see Applicant's Arguments/Remarks pages 9-10). Examiner respectfully disagrees. Durso also teaches "The audio broadcast unit may be removed from the bistable band and attached to a belt, body part, or other attachable object for use independently of the bistable band." Thus, Applicant's argument is moot.

Conversely, Durso teaches of a golf swing touch trainer (Col. 2 Line 23) and method that is portable wherein the base can include spiking into the ground or a material made of small hooks that can be releasably attached to a fabric (Figs. 1-5 "golf swing touch trainer 100" and "It is a generally portable item, i.e., is portably-sized, although it may be fastened to a surface more permanently such as by spiking, gluing, or otherwise affixing it permanently or removably, e.g., by making it to have its bottom surface include a hook portion of a hook and loop substance such as VELCRO (Reg.

U.S. Pat. & Tm. Off.) fastener material, which may attach to a complimentary loop portion which may include the pile of certain carpets. Preferably, the trainer 100 is fully portable and if attachable, removably attachable" (Col. 3 Lines 18-28); and wherein "The trainer is placed on a suitable surface such as an actual grass or sand putting green, artificial turf, a carpet or rug, and so forth" (col. 5 Lines 15-17) in order to help a student of the game of golf to effectively, rather, quickly, not only develop his aim, but also, most importantly, develop his golf swing touch, especially with stokes of putting and chipping" (Col. 2 Lines 38-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the fastening means and placement on a carpet as taught by Durso into the teachings of Bart as modified by Wash in order to help a student of the game of golf to develop his aim and sense of golf swing touch, especially with stokes of putting and chipping.

11. Applicant argues it would not be practical to reverse the spring and ferrule in the sensor switch of Williams (see Applicant's Arguments/Remarks pages 10-11). Examiner respectfully disagrees. Williams teaches of a bumper sensor (Figs. 1-4) whereby upon impact by ball 36 rolling over a board 12 may engage the side of the spring 10 and move the latter in a radial direction toward the mounting post so as to cause the central contact ring portion 17-17a to bear against the sleeve 14, thus closing a circuit (Page 2, Col. 1, Lines 15-31) in order to provide an improved bumper switch for use in an amusement apparatus (Page 1, Col. 1, Lines 1-9). However, Williams teaches the claimed sensor limitation except for the spring 10 is outside of (not inside

of) ferrule 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reverse the parts since it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling, II can be reached on (571) 272-4437. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/  
Examiner, Art Unit 3714